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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,283	02/15/2002	Makoto Iwayama	NIT-163-02	9044
24956	7590	01/09/2008		
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT 2165	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

AK

Office Action Summary

Application No.

10/075,283

Applicant(s)

IWAYAMA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23-October -2007 has been entered.
2. The amendment filed on 23-October -2007 has been received and entered. Claims 11-17 are pending.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), but not considered. A benefit claim to U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Therefore, the earliest priority date claimed is 11/18/1999.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

While, Applicant's disclosure pages 10-12 appears to describe capriciously the claimed invention; however in the same token, the disclosure itself on page 11, lines 5-14, explicitly states that "the more advanced search... is omitted from the preferred embodiment but explained in Japanese Patent" hence making an afterthought and un-defined in the instant disclosure. It is unclear how a person of ordinary skill in the art is able to practice the invention. There is neither written description nor practiced embodiment that can adequately enable and support the claimed invention. Therefore, the Examiner is unclear what is being claimed in light of this disclosure and more so since the Examiner does not speak Japanese; thus difficult to ascertain the support for those additional options (i.e. automatically broadening or narrowing search terms in a second database).

While, the disclosure on page 11, lines 20-28, instead provides for:

Subsequently, if the user is interested in handling other document data for the set of documents corresponding to this search result, he may change the document database in the window MI, and press the button B1 to begin a new search. Hence, the client sends an identifier of the 25 plural documents selected to the server where the source document database is stored (for example, the server 13), obtains a summary of these plural documents, sends this summary to the server where the target document database is stored (for example, the server 14), and obtains a search result from the target server (for example, the server 14). The new search result is displayed in the window PI. In other words, in this case, P1 is updated by the set of documents, which was newly searched.

So in fact the a new search is nothing more than a second search using the same original input (i.e. single input) to a different database not different from what is clearly taught in previously cited prior art Subramaniam et al. Figure 5A, and column 9, lines 23-37. This is one

interpretation. While, another can be just simply refining a query within a selected database based on extracted keywords from preprocessed documents. Clarification and corresponding support is required.

Furthermore, there is no support for "automatically searching a second database" instead it appears to be a manual selection by the user from the drop-down menu.

Applicant's specification paragraph [0011]:

As the search interface of the client, a display area for a set of documents is first provided wherein the required set of key documents can be specified, and the database to be searched can also be selected. In the client, the user then selects an interesting set of documents from among a set of documents displayed in this display area, and if necessary, changes over the document database which is to be searched.

Applicant's specification paragraph [0027]:

E1 is a window for inputting a search query, wherein the user can input a search query by a string of keywords or in the form of a sentence. M1 is a window for selecting a document database wherein the user can pull down a specific part on the right edge with a mouse to show a list of document databases, and select a desired document database. B1 is a search button which initiates a search.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the relevance" in line 24. There is insufficient antecedent basis for this limitation in the claim.

Claim 11, line 23 recites “wherein each term in said weighted term list is given a weight based on an importance of the term both in the first document database and the second document database”; However, the limitation prior to this states “weighted term list is used as a second search input that performs said search of said second database”... then it is incomprehensible how the same list which had not existed in the second database yet (it was submitted as input) can include importance from the second database? The recitations are confusing.

Claim 11, line 26, recites “at least one document input to said first document database is selected or deselected” leading the Examiner to believe the database itself is being selected/deselected, while the only support found in the specification paragraphs 0028, and 0031 is that the documents are selected/deselected. Correction and clarification in the claims is respectfully required.

Claim 14, line 26, recites “wherein a summary containing only topic words in said at least one document is used to perform the second search” which contradicts the previous statement in the same claim in line 20 that the second search input is the weighted list produced by the first document database. Correction and clarification is requested.

In general, the claims as a whole appear to be confusing and contradictory in many aspects to the specification.

While the claim may recite, using one and only document summary to search various databases; Applicant's specification specifies that document summary is only made relative to the selected database and an original search is refined only within the selected database. It is clear that the invention is nothing more than extracting relevant keyword from user's queries and constructing an index (source database) used to search a remote database (target database).

Applicant's specification explicitly recites a new summary and a new search is needed once a new database is selected manually by the user.

[0032] Subsequently, if the user is interested in handling other document data for the set of documents corresponding to this search result, *he may change the document database in the window M1, and press the button B1 to begin a new search.*

[0033] Hence, the client sends an identifier of the plural documents selected to the server where the source document database is stored (for example, the server 13), *obtains a summary of these plural documents (Clearly new summary, not the original one)*, sends this summary to the server where the target document database is stored (for example, the server 14), and obtains a search result from the target server (for example, the server 14). The new search result is displayed in the window P1. In other words, in this case, P1 is updated by the set of documents which was newly searched.

[0034] To compare a new search result with a previous search result, the user may press a back button B2 to re-display the previous search result in the window P1, and return the display of the window P1 *to its state before search was performed*. Likewise, the window P1 can be advanced to the new search result by pushing a forward button B3.

[0035] As the user can search other document databases corresponding to such a search result at any stage of the search, *the user can freely proceed from one database to another database by repeating the search cycle*. Naturally, it is also possible to repeat this cycle within the same document database, i.e., without changing the document database.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishioka et al. (U.S. Patent No. 6,457,004 B1).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claim 11, Nishioka et al. discloses a computer implemented service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search, said service providing a document search method comprising the steps of:

making a first search input of a set of keywords, fragments of a document or any desired set of documents to a first document database (See column 11, lines 1-6);

conducting a first search of said first document database based in said first search input (See Figure 5, 3441MR, shows keyword search, also see column 10, lines 60-67);

retrieving at least one document as a result of said first search (See column 9, lines 8-16);

inputting said at least one retrieved document to said first document database (See column 9, lines 8-16);

making a weighted term list, whereby each term is given a weight, from said input of said at least one retrieved document to said first document database, the weight of each term reflecting the importance of the term in the first document database (See column 9, lines 30-46),

automatically performing a second search of a second document database based on said weighted term list from said first document database (See column 24, lines 63-67, and see column 25, lines 1-30);

wherein said weighted term list is used as a second search input that performs said search of said second document database (See column 24, lines 63-67, and see column 25, lines 1-30), and

wherein each term in said weighted term list is given a weight based on an importance of the term both in the first document database and the second document database, and the weight of each term is used to calculate the relevance of each document of the second document database (See column 31, lines 41-64); and

wherein an interface is provided in which any of said at least one document input to said first document database is selected or deselected, and a set of said at least one document that is selected via said interface is used in preparing the second search input that searches said second document database (See column 14, lines 33-61); and

displaying result of said search on a display unit (See Figure 4, shows all data capable of being displayed on display unit).

As to claim 12, Nishioka et al. discloses wherein a summary containing only topic words in said at least one document is used to perform the second search (See column 12, lines 1-67).

As to claims 13, and 17, Nishioka et al. discloses wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See column 11, lines 31-55).

Independent claim 14 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein a summary containing only topic words in said at least one document is used to perform the second search (See corresponding rejection for claim 12 above).

Independent claim 15 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See corresponding rejection for claim 13 above).

As to claim 16, Nishioka et al. discloses wherein said server where said first document database is stored produces a summary from topic words relevancy to said at least one document sent by the client and transmits the summary to the client, and further searches and transmits to the client a set of documents having a high relevance to said second search input sent by the client (See column 7, lines 25-35, and see column 11, lines 40-51, wherein "having a high relevance to said second search" reads on "documents" retrieval as related concepts to the expanded search result, "associative search").

Alternatively, the claims are rejected under:

10. Claims 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Barr et al. (U.S. Patent No. 5,873,076).

As to claim 11, Barr et al. discloses a computer implemented service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search (See Figure 3, DB 117, DB 118, wherein each document database includes a server associated with it), said service providing a document search method comprising the steps of:

making a first search input of a set of keywords, fragments of a document or any desired set of documents to a first document database (See Figure 2, 202);

conducting a first search of said first document database based in said first search input
(See column 4, lines 43-45);

retrieving at least one document as a result of said first search (See column 4, lines 45-48);

inputting said at least one retrieved document to said first document database (See column 3, lines 20-26, and see column 11, lines 16-20);

making a weighted term list, whereby each term is given a weight (See Figure 5A), from said input of said at least one retrieved document to said first document database, the weight of each term reflecting the importance of the term in the first document database (See column 4, lines 19-23, and column 12, lines 54-65, shows parsing the document to form an index then using the index once a query is performed),

automatically performing a second search of a second document database based on said weighted term list from said first document database (See Figure 4A, wherein "advanced searching" bottom is shows 349a, also see column 2, lines 29-34);

wherein said weighted term list is used as a second search input that performs said search of said second document database (See column 3, lines 38-42), and

wherein each term in said weighted term list is given a weight based on an importance of the term both in the first document database and the second document database, and the weight of each term is used to calculate the relevance of each document of the second document database (See column 4, lines 19-33, wherein the search result retrieves both DB data wherein the search is expanded); and

wherein an interface is provided in which any of said at least one document input to said first document database is selected or deselected, and a set of said at least one document that is selected via said interface is used in preparing the second search input that searches said second document database (See column 15, lines 1-5, and see Figure 4, 350); and

displaying result of said search on a display unit (See column 14, lines 15-25).

As to claim 12, Barr et al. discloses wherein a summary containing only topic words in said at least one document is used to perform the second search (See column 9, lines 9-21, and see column 10, lines 5-15).

As to claims 13, and 17, Barr et al. discloses wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See column 36, lines 38-52, wherein "user's evaluation" is read on "user feedback").

Independent claim 14 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein a summary containing only topic words in said at least one document is used to perform the second search (See corresponding rejection for claim 12 above).

Independent claim 15 is directed to similar limitations as claim 11 above and thus rejected under the same rational, with the only difference of stating:

wherein the client transmits said at least one document to a server where said first document database is stored, receives a summary comprising only topic words related to said at least one document which is sent, sends the second search input corresponding to said summary reflecting a user's evaluation of the summary to the server where said second document database is stored, and receives a search result from the search of said second document database (See corresponding rejection for claim 13 above).

As to claim 16, Barr et al. discloses wherein said server where said first document database is stored produces a summary from topic words relevancy to said at least one document sent by the client and transmits the summary to the client, and further searches and transmits to the client a set of documents having a high relevance to said second search input sent by the client (See column 3, lines 38-54).

Response to Arguments

11. Applicant's arguments with respect to claims 11-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liddy et al. (U.S. Patent No. 5,963,940) teaches GUI providing various dropdown menus after document processing for different databases.

Kepler et al. (U.S. Patent No. 6,745,177 B2) teaches retrieving data from multiple databases using search routing database.

For complete list of cited relevant prior art, see PTO-Form 892.

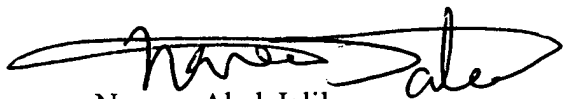
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Naveen', followed by a large, stylized flourish that extends to the right.

Neveen Abel-Jalil
Primary Examiner
January 5, 2008